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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,128	08/03/2001	Brian Davidson	367.40418X00	6447

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EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/921,128	<b>Applicant(s)</b> DAVIDSON ET AL.	
	<b>Examiner</b> Bradley Edelman	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/30/02, 1/6/04, 5/17/04</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is a first action on the merits of this application. Claims 1-12 and 14-18 are presented for examination.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Great Britain on July 2, 2001. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

#### ***Claim Objections***

1. Claims 17 and 18 are objected to because of the following informalities: they contain the phrase "any of claims 2" and "any of claims 3" respectively. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of these claims contains the term "and/or" which is indefinite. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Tikka et al. (PCT Publication No. WO 99/26431, hereinafter "Tikka").

Note, for the claims, the term e-tag is interpreted to mean "any electronic message" as defined in the specification (p. 1, line 22).

In considering claim 1, Tikka (see Fig. 1) discloses a system comprising first means adapted to be user actuable for creating an e-tag (step A) and comprising means for defining one or more intended recipients of said e-tag (step B) and means for defining a location condition associated with said e-tag (step C), and second means adapted to be responsive to said e-tag such that said one or more intended recipients is notified of said e-tag when said location condition is fulfilled (steps D-F).

In considering claim 2, Tikka further discloses that said second means comprises means for receiving the e-tag and means for executing the e-tag including means for monitoring an area associated with said location condition and detecting for said one or more intended recipients and means for transmitting the e-tag to detected ones of said one or more intended recipients in response to the monitoring means determining a

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correspondence between a detected intended recipient and the one or more recipients defined in said e-tag (Fig. 1, steps D-F; see also, p. 4, line 34 – col. 5, line 9).

In considering claims 3 and 14, Tikka further discloses that the first means is provided by a client terminal ("computer terminal," p. 5, lines 28-32).

In considering claim 4, 15, and 16, Tikka further discloses that the second means is provided by an e-tag service site ("service unit 1," p. 5, lines 14-17).

In considering claim 5, Tikka further discloses that the e-tag service site comprises a server ("service unit 1") linked to a detector ("BSC") for detecting users in a pre-defined area and a transmitter ("BTS"), said server including a processor and a memory (inherent), said processor being configured to compare a detected user with an intended recipient list and instructing said transmitter to transmit said e-tag when said processor determines a match between said detected user and an intended recipient (p. 5, line 33 – p. 6, line 9; Fig. 1, steps D-F).

In considering claims 6, 17, and 18, Tikka further discloses that the second means is provided by a network (Fig. 2, wherein the network is connected to the service unit).

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In considering claim 7, claim 7 presents the same limitations as claim 1, but replaces the word "location condition" with "event condition." Tikka teaches this, wherein the "event" consists of the recipient moving into the area defined by the sender, such that the recipient is notified of the message when the event is satisfied.

In considering claim 8, claim 8 presents a device for performing the same steps as described in claims 1 and 2 combined, and is thus rejected for the same reasons.

In considering claims 9-12, these claims present methods, computer programs, and a client terminal for performing the same steps (actually fewer steps, as these claims are broader than claim 1) as claim 1, and are thus rejected for the same reasons.

4. Claims 7, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Leary ("Ecards Ease Greeting Card Woes," EContent, March 2000).

In considering claim 7, O'Leary discloses a system comprising first means adapted to be user actuable for creating an e-tag (i.e. user writes a personal message) and comprising means for defining one or more intended recipients of said e-tag ("recipient's name [and] e-mail address") and means for defining an event condition associated with said e-tag (i.e. choosing a date to send), and second means adapted to be responsive to said e-tag such that said one or more intended recipients is notified of said e-tag when said event condition is fulfilled (i.e. message is sent on the date selected, see p. 2, first full paragraph).

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In considering claims 9-12, these claims present methods, computer programs, and a client terminal for performing the same steps (actually fewer steps, as these claims are broader than claim 7) as claim 7, and are thus rejected for the same reasons.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 703-306-3041. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Bradley Edelman*

BE

October 4, 2004